

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1-8 were pending in this application. In this response, claims 1-8 have been amended and claims 9-19 have been added. Thus, claims 1-19 are now currently pending.

Support for the foregoing added claims can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification at page 8, lines 5-10 and page 9, lines 5-26. The amendments to claims 1-8 were made to delete reference numbers in the claims and to replace “characterized in that” with “wherein” for purposes of form and not for reasons of patentability.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-3 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,146,060 to Rydberg et al. (hereafter “*Rydberg*”) for the reasons presented at page 2 of the Official Action.

The rejection of applicants' claims as outlined on page 2 of the Official Action are improper as an anticipation rejection because each of the rejections has failed to teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For each of the rejections outlined in the Official Action, at least one element of the claims are not expressly or inherently described in the cited reference. Accordingly, the rejections are improper and should be withdrawn.

First, claims 1, 2, and 8 each require at least three sets of ridges. Two sets of first ridges and at least one set of transverse ridges. *Rydberg* fails to describe this element. The Examiner has misinterpreted the definitions of the reference characters in *Rydberg*. Reference numbers 16A and 16B refer to two separate sets of grooves, while reference numbers 17A and 17B refer to individual grooves within the separate sets of grooves (16A, 16B) respectively. The individual groove (17B) cannot be defined as a surface field or set of a plurality of mutually parallel, first ridges. Furthermore, the set of grooves (16A) cannot be defined as an individual groove forming one of a plurality of mutually parallel, first ridges. Therefore, there are only two sets of ridges defined in *Rydberg*. A first set of first ridges (16A) and a second set of transverse ridges (16B). *Rydberg* fails to describe two sets of first ridges in addition to at least one set of transverse ridges.

Second, claims 1, 2, and 8 each require the limitation “two spaced-apart surface fields or sets of a plurality of mutually parallel, first ridges.” *Rydberg* fails to describe this element. It appears the Examiner is suggesting that portions of the single set of grooves (16B, the Examiner incorrectly refers to the set by reference number 17B) on either side of the hole (15) represent the two spaced-apart sets of a plurality of mutually parallel, first ridges. However, the two portions of the single set of grooves (16B) meet where the hole (15) is not present and therefore the two portions are not “spaced-apart.”

Third, claims 1, 2, and 8 each require the limitation “one or more second, transverse ridges (19), which are located between the two sets of first ridges (18A, 18B).” *Rydberg* fails to describe this element. The Examiner has not explained how this limitation is met by *Rydberg*. However, if the Examiner takes the position that the hole (15) separates the two portions of the single set of grooves (16B), then the hole (15) must be considered a separate element of the

cutting tool. Therefore, the only element of the cutting tool located between the two portions of the single set of grooves (16B) is the hole (15). Thus, no “one or more second, transverse ridges” is located between the two portions of the single set of grooves (16B).

Dependent claim 3 is also not anticipated for at least the same reasons as for claim 2 from which it depends. Withdrawal of the rejection as to claim 3 is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rydberg* for the reasons presented at page 3 of the Official Action.

The rejection of applicants' claims as outlined on page 3 of the Official Action is improper as an obviousness rejection because the rejection has failed to establish a *prima facie* case of obviousness. As outlined in M.P.E.P. §§2141.02 and 2143.03, the references must teach or suggest all of the claim limitations. For each of the rejections outlined in the Official Action, at least one element of the claims are not taught in the cited reference. Furthermore, there is no reasoned statement explaining the basis for any modification of the cited references in support of an obviousness rejection of the claims as presently presented. This is improper as an obviousness rejection (see, page 57528 of the Federal Register, Vol. 72, No. 195 of Wednesday, October 10, 2007, where it states “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”). Accordingly, the rejection is improper and should be withdrawn.

Rydberg does not teach or suggest all of the claim limitations of each of the dependent claims 4-7. As explained above, *Rydberg* does not teach all of the limitations of claim 2.

Furthermore, *Rydberg* does not teach or suggest all of the specific limitations in the dependent claims.

The Examiner has misinterpreted the quoted passage from *Rydberg*. This passage when read in context with the rest of *Rydberg* only teaches that the two sets of grooves while remaining in parallel to each other can be placed at an angle in relation to the workpiece.

Claim 4 requires the limitation "a third type of serrations are formed in the form of a plurality of tops." *Rydberg* fails to describe this element. A teaching that two sets of grooves can be placed at an angle in relation to the workpiece provides no suggestion for modifying the connecting surface to include a third type of serrations in the form of a plurality of tops. The Examiner has also relied on *In re Japikse* for the notion that rearranging parts of an invention involves only routine skill in the art. However, the requirement in claim 4 is for an additional part not mere rearrangement of existing parts so this legal precedent is not germane to the obviousness of claim 4.

Claims 5-7 require the crest of the transverse ridge or ridges be situated in another plane than the crests of the first ridges. *Rydberg* fails to describe this element. A teaching that two sets of grooves can be placed at an angle in relation to the workpiece provides no suggestion for the crests of the transverse ridges to be in a different plane than the crests of the first ridges. *Rydberg* is silent to the height of each crest and all of the figures in *Rydberg* appear to show all of the crests in the same plane. Therefore, there is no suggestion in *Rydberg* that crests from the transverse ridges would be in a different plane than the crests of the first ridges. Here again, the Examiner has also relied on *In re Japikse* for the notion that rearranging parts of an invention involves only routine skill in the art. However, placing one set of ridges in a different plane from another set of ridges for a particular purpose is not merely rearranging parts. Furthermore, *In re*

Japikse did not hold that any rearranging of parts of an invention involves only routine skill in the art. It only held that there was no invention in shifting a starting switch to a different position on the device because the operation of the device was not modified. See *In re Japikse*, 86 USPQ 70, 73 (CCPA 1950). In contrast, placing some ridges in a separate plane than other ridges would modify the operation of the device because it would have different surfaces bearing the transverse forces than when the ridges are in the same plane.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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